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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,672	06/01/2001	Ryota Sugimoto	018961-054	8651

39083 7590 03/23/2007
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EXAMINER

MATHEW, FENN C

ART UNIT	PAPER NUMBER
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3764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/23/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/870,672
Filing Date: June 01, 2001
Appellant(s): SUGIMOTO, RYOTA

MAILED
MAR 23 2007
Group 3700

David J. Kenealy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 5, 2006 appealing from the Office action mailed September 7, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. 6,293,967 Shanley U.S. 5,788,979 Alt et al.

WO99/23977 Palmaz

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 1, 4, 5, 9-13, 20, 22-23, 32-37, and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley (6,293,967) in view of Palmaz (WO99/23977). Please refer to paragraph numbered 2 of the office action mailed 09/07/2005.

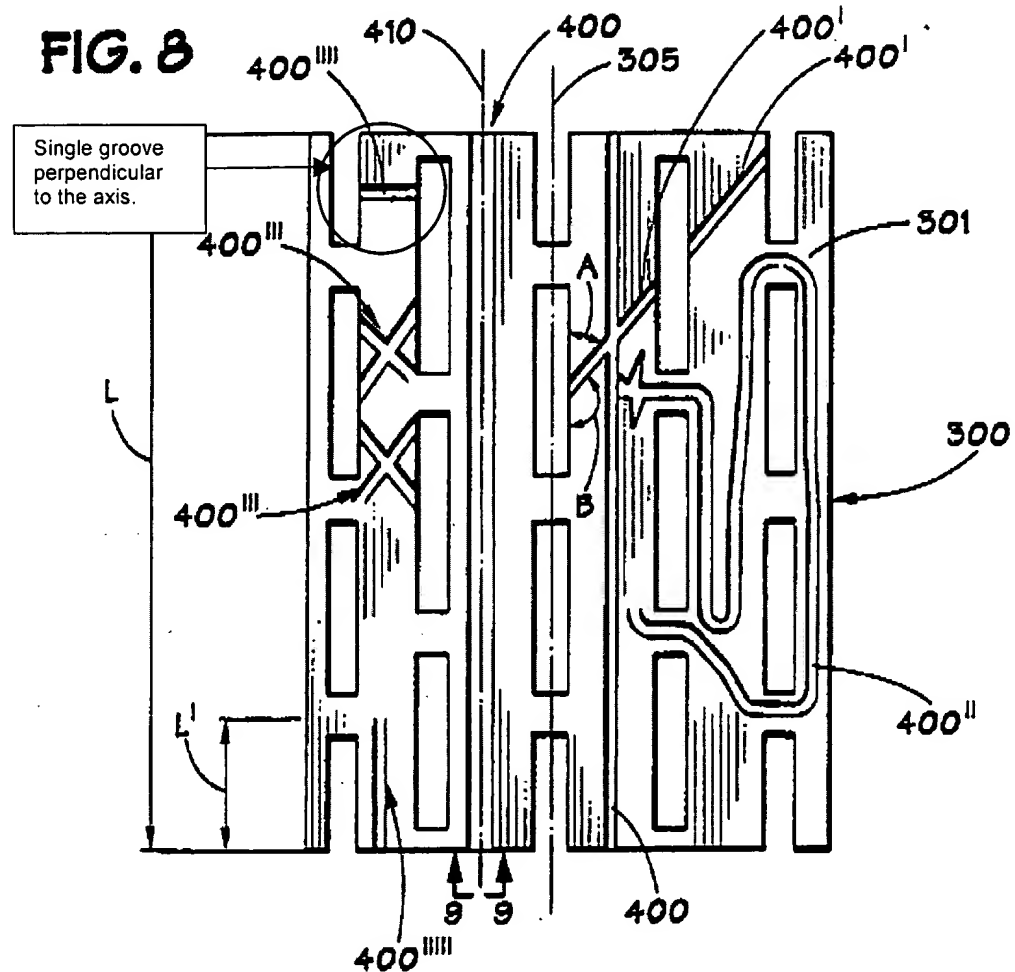
Claims 14-19 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley (6,293,967) in view of Palmaz (WO99/23977) as applied to claim 1 above, and further in view of Alt et al. (5,788,979). Please refer to paragraph numbered 3 in the office action mailed 09/07/2005.

(10) Response to Argument

In summary, Applicant has argued that the rejections over Shanley '967 in view of Palmaz '977 fail to meet the *prima facie* requirements for obviousness. With regards to limitations drawn towards the 'deformable portions' forming an endless annular configuration or a spiral configuration, Examiner disagrees with Applicant's arguments. Examiner erroneously utilized the word 'serpentine' in the rejection. Nonetheless Examiner respectfully believes Palmaz provides basis for annular configuration or spiral

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configuration of the deformable portions. Examiner relied upon figure 8 of Palmaz as



copied below:

Reference numeral 400''' shows a single groove extending across a portion of the stent. The groove 400''' extends perpendicular to axial lengthwise direction of the stent. Figure 8 of Palmaz is used to illustrate the different types of grooves that may be utilized. Applicant has argued that there is no support in the specification of Palmaz providing motivation for extending the groove along the stent body in an annular configuration. Examiner respectfully disagrees noting page 8, lines 9-11: "Grooves 400, 400', 400'', 400''', and 400'''' could be provided alone or in combination with each other,

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as desired, **including a symmetrical**, or an asymmetrical pattern of grooves. Clearly a symmetrical pattern of grooves 400''' would result in an endless annular configuration.

Likewise, with respect to the limitations drawn towards the spiral configuration, Examiner respectfully points out grooves 400', noting that they form a diagonal pattern, and that continuity of such a pattern would lead to a spiral configuration. Noting the portions of Palmaz's specification cited above, Examiner feels that a *prima facie* case of obviousness has been drawn from the teachings of the prior art themselves.

With regards to arguments drawn towards placement of grooves on the bent portions, Examiner once again refers to the specification of Palmaz, which teaches that grooves may be placed anywhere on the stent as desired. Examiner thoroughly disagrees with Applicant's characterization of the rejection based on the combination of Shanley and Palmaz being akin to combining any gene sequence to obviate over a new gene sequence discovery. The fields of invention are simply not comparable, and furthermore, as stated by the Applicant, such a combination or statement could only be based on teachings of the prior art or the knowledge of one with ordinary skill in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As stated above, simply put, Palmaz teaches the desirability of placing grooves on any portion of a stent. Contrary to Applicant's argument, this does not preclude placing grooves on the wavy annular members or bent portions of Palmaz. Examiner notes that Applicant has stated that placement of grooves on the S-shaped bridges of Shanley would result in inoperability of Shanley. Examiner respectfully disagrees. The grooves of Palmaz are, as Applicant pointed out, provided to aid in endothelial cell migration. Hence, the teachings of Palmaz to place the grooves along any desired portion of the stent have merit. Examiner further contends that based on the teachings of Palmaz, an appropriate groove depth would be selected in order to prevent destruction of the Shanley reference. In response to applicant's argument that modification of Shanley by Palmaz, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

With respect to claims 14-19 and 44-45, Applicant's arguments are drawn to supposed deficiencies in Palmaz and Shanley which have been addressed above.


For the above reasons, it is respectfully submitted that the rejections of claims 1, 4, 5, 9-20, 22, 23, and 32-45 should be sustained.

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Conferees:

Respectfully Submitted


Cary O'Connor


Fenn C. Mathew


Stephen Cronin

March 19, 2007